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PTO/SB/21 (08-00)

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TRANSMITTAL FORM		Application Number	09/911,024
(to be used for all correspondence after initial filing)		Filing Date	12 July 2001
		First Named Inventor	S. REUNING
		Group Art Unit	3625
		Examiner Name	Ouellette
Total Number of Pages in This Submission	5	Attorney Docket Number	Diedre

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DEC 26 2006

In The United States Patent Office
Board Of Patent Appeals

5

Ex parte Application of Stephen
Michael REUNING *et al.*,
Automated Prospector ...
Patent Application Serial No.
09/911,024

Appeal No. 2006-0580

10

15

REQUEST FOR REHEARING

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This is a REQUEST FOR REHEARING pursuant to Rule 1.197(b). This is submitted within two months from the date of the original decision, and therefore is believed timely filed.

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Applicant respectfully thanks the Board of Appeals for recognizing that claims 1 and 2 are allowable.

Claims 3 to 66 were rejected as obvious over MOSSBERG combined with HARTMAN and BOGURAEV or PEACH. The Board did not reverse this rejection because "the appellants have not presented any patentability arguments for these claims." *See Ex parte Reuning*, (Appeal No. 2006-0580) slip op. at 4 (Nov. 30, 2006). Applicant respectfully requests reconsideration because the

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appellants did in fact present both evidence and argument showing patentability of claims 3 to 66.

5 Appellant Has Presented
Evidence Showing That Claims
3 To 66 Are Non-Obvious

For example, these claims stand rejected as obvious over MOSSBERG. Several years before this appeal was filed, however, Appellant filed a RULE 131 DECLARATION antedating MOSSBERG. Appellant's APPEAL BRIEF explained how this evidence shows the patentability of claims 3 to 66. *See* APPEAL BRIEF (27 April 2004) at e.g. 6:9-12.

Similarly, Appellant's APPEAL BRIEF explained how the Examiner has already made an administrative agency fact-finding that the invention of claims 3 to 66 exhibits patentable synergy *vis* the prior art of record. *See* APPEAL BRIEF (27 April 2004) at e.g. 15:6-15.

15 Appellant Has Presented
Argument Explaining How Claims
3 To 66 Are Non-Obvious

Appellant presented argument explaining how the references fail to suggest the combination of claims 3 to 66, and indeed *teach away from* that combination. *See* APPEAL BRIEF (27 April 2004) at, e.g., 13:3 to 15:5 (HARTMAN); 16:5-17 and 17:1 to 18:3 (BOGURAYEV); 18:5-18 (PEACH).

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Similarly, Appellant explained how the Examiner had failed to even plead a *prima facie* case of obviousness, because the Examiner had failed to show how each element of each of claims 3 to 66 (indeed, failed to show how each element of *any* claim) was taught by the art of record. See APPEAL BRIEF (27 April 5 2004) at, e.g., 12:15 to 13:2.

Summary

Appellant respectfully asks the Board to reconsider its decision on claims 3 to 66 and withdraw the rejection of these claims.

10 Respectfully submitted on behalf of Appellant by its attorneys,
PHARMACEUTICAL PATENT ATTORNEYS, LLC

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26 December 2006

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